

REMARKS

Claims 59-150 are now pending. No claims are allowed. Claims 59-150 were rejected in an office action dated July 16, 2003.

The 35 U.S.C. § 102(a) Rejection

Claims 59-67, 69-75, 77-84, 86-92, 94-107, 109-121, 123-135, and 137-149 stand rejected under 35 U.S.C. § 102(a) as being anticipated by "Java Card™ Virtual Machine Specification: Java Card Version 2.1 Draft 2a (hereinafter "Draft 2a")".¹

According to the M.P.E.P., a claim is anticipated under 35 U.S.C. § 102(a), (b) and (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.² "The identical invention must be shown in as complete detail as contained in the claim."³ "The elements must be arranged as required by the claim..."⁴

Also according to the M.P.E.P.,

A reference is proven to be a "printed publication" "upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it." *In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981) (quoting *I.C.E. Corp. v. Armco Steel Corp.*, 250 F. Supp. 738, 743, 148 USPQ 537, 540 (SDNY 1966)) ... See also *Carella v. Starlight Archery*, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986) (Starlight Archery argued that Carella's patent claims to an archery sight were anticipated under 35 U.S.C. 102(a) by an advertisement in a Wisconsin Bow Hunter Association (WBHA) magazine and a WBHA mailer prepared prior to Carella's filing date. However, there was no evidence as to when the mailer was received by any of the

¹ Office Action dated July 16, 2003, ¶ 3.

² Manual of Patent Examining Procedure (MPEP) § 2131. See also *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

³ *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

⁴ *Id.*

addressees. Plus, the magazine had not been mailed until 10 days after Carella's filing date. The court held that since there was no proof that either the advertisement or mailer was accessible to any member of the public before the filing date there could be no rejection under 35 U.S.C. 102(a).⁵

In determining the date of availability as prior art of an electronic publication, the M.P.E.P. states:

Prior art disclosures on the Internet or on an on-line database are considered to be publicly available as of the date the item was publicly posted. If the publication does not include a **publication date** (or **retrieval date**), it cannot be relied upon as prior art under 35 U.S.C. 102(a) or (b), although it may be relied upon to provide evidence regarding the state of the art. Examiners may ask the Scientific and Technical Information Center to find the earliest date of publication. See MPEP § 901.06(a), paragraph IV. G.⁶

The Applicants respectfully submit that Draft 2a is not a proper reference for a rejection under 35 U.S.C. § 102(a). Draft 2a was included as an unpublished draft in an Appendix to the application as filed on February 2, 1999. Draft 2a is dated January 29, 1999. However, the Applicants respectfully submit the January 29, 1999 date is not the date of **publication**. The final revision of the "Java Card™ Virtual Machine Specification: Java Card Version 2.1" document was not made available to any member of the public until after the February 2, 1999 filing date.

The Applicants further submit that the application as filed unambiguously indicates Draft 2a is part of the specification and not prior art. The specification states:

In addition, an Appendix entitled Java Card™ Virtual Machine Specification: Java Card Version 2.1" is attached to this application and **forms part of the present specification**.⁷

Draft 2a and a separate publication are also referenced elsewhere in the specification:

⁵ MPEP § 2128.

⁶ *Id.*(emphasis added)

Further details of the structure of an exemplary CAP file 16 are discussed in the attached Appendix at pages 53 through 94 and in a publication by Sun Microsystems, Inc. entitled "Java Card Runtime Environment (JCRE) 2.1 Specification," (1998) which is incorporated herein by reference in its entirety.⁸

Draft 2a is referenced again later in the specification:

Various keywords, which cannot be used as identifiers or names of declared entities, are supported by the Java Card Virtual Machine 49. A list of the supported keywords is provided in the attached Appendix at page 11.⁹

Draft 2a is referenced yet again later in the specification:

Detailed explanations of each instruction including its function and effect on the operand stack appear in the attached Appendix at pages 97 through 215.¹⁰

For the above reasons, the rejection of claims 59-67, 69-75, 77-84, 86-92, 94-107, 109-121, 123-135, and 137-149 under 35 U.S.C. 102(a) is improper and should be withdrawn.

The 35 U.S.C. § 103(a) Rejection

Claims 68, 76, 85, 93, 108, 122, 136, and 150 stand rejected under 35 U.S.C. § 103(a) as obvious over Draft 2a in view of Wilkinson et al.^{11 12} Claims 68, 76, 85, 93, 108, 122, 136, and 150 depend from independent claims 59, 69, 77, 87, 95, 109, and 123, respectively. As mentioned above, Draft 2a is invalid as a reference under 35 U.S.C. 102(a). For the same reasons, Draft 2a is unavailable as a reference under 35 U.S.C. 103(a). Accordingly, the 35 U.S.C. 103(a) rejection with respect to claims 68, 76, 85, 93, 108, 122, 136, and 150 is improper and should be withdrawn.

⁷ Specification at p. 1 lines 23-26. (emphasis added)

⁸ Specification at p. 10 lines 21-26.

⁹ Specification at p. 14 lines 8-11.

¹⁰ Specification at p. 15 line 33 – p. 16 line 3.

¹¹ USP 6,308,317.

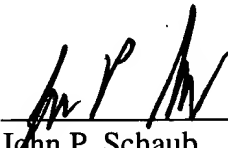
Request for Allowance

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below. The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1698.

Respectfully submitted,
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¹² Office Action ¶ 4.